

**PETITION FOR REVIVAL OF AN APPLICATION FOR PATENT ABANDONED
UNINTENTIONALLY UNDER 37 CFR 1.137(b)**

Docket Number (Optional)
003921.00258

First named inventor: Amr M. MOHSEN

Application No.: 08/632,298

Filed: April 12, 1996

Title: FIELD PROGRAMMABLE PRINTED CIRCUIT BOARD

Attention: Office of Petitions

Mail Stop Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

FAX: (571) 273-8300

Art Unit: 2304

Examiner: Hugh M. Jones

NOTE: If information or assistance is needed in completing this form, please contact Petitions Information at (571) 272-3282.

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the Office notice or action plus any extensions of time actually obtained.

APPLICANT HEREBY PETITIONS FOR REVIVAL OF THIS APPLICATION

NOTE: A grantable petition requires the following items:

- (1) Petition fee;
- (2) Reply and/or issue fee;
- (3) Terminal disclaimer with disclaimer fee -- required for all utility and plant applications filed before June 8, 1995; and for all design applications; and
- (4) Statement that the entire delay was unintentional.

1. Petition fee

☐ Small entity - fee \$_____ (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☒ Other than small entity - fee \$1500.00 (37 CFR 1.17(m))

2. Reply and/or fee

A. The reply and/or fee to the above-noted Office action in the form of Response (identify type of reply):

- ☐ has been filed previously on _____.
- ☒ is enclosed herewith.

B. The issue fee and publication fee (if applicable) of \$ 1210.00

- ☒ has been paid previously on May 19, 2000.
- ☐ is enclosed herewith.

[Page 1 of 2]

This collection of information is required by 37 CFR 1.137. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 1.0 hour to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

04/04/2006 HALI11 00000001 190733 08L32298

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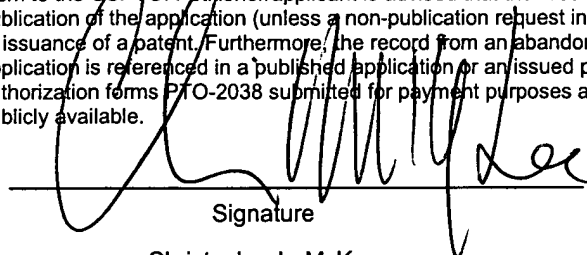
3. Terminal disclaimer with disclaimer fee

- ☒ Since this utility/plant application was filed on or after June 8, 1995, no terminal disclaimer is required.
- ☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$_____ for a small entity or \$_____ for other than a small entity) disclaiming a period equivalent to the period of abandonment is enclosed herewith (see PTO/SB/63).

4. Statement. The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional. [NOTE: The United States Patent and Trademark Office may require additional information if there is a question as to whether either the abandonment or the delay in filing a petition under 37 CFR 1.137(b) was unintentional (MPEP 711.03(c)(III)(C) and (D))].

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.


 Signature

Christopher L. McKee

Typed or printed name

32,384

Registration No., if applicable

 3/31/06
 Date

 Banner & Witcoff, Ltd.
 1001 G Street, N.W., 11th Fl.
 Washington, D.C. 20001-4597

Address

202-824-3000

Telephone No.

Enclosures: ☒ Fee Payment☒ Reply☐ Terminal Disclaimer Form☐ Additional sheets containing statements establishing unintentional delay☐ Other : _____**CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(A)]**

I hereby certify that this correspondence is being:

☐ deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to: **Mail Stop Petition**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

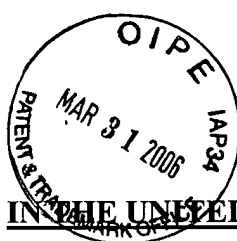
☐ transmitted by facsimile on the date shown below to the Patent and Trademark Office at (571) 273-8300.

Date

Signature

Christopher L. McKee

Typed or printed name of person signing certificate



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Amr M. MOHSEN

Serial No.: 08/632,298

Filed: April 12, 1996

For: Field Programmable Printed Circuit
Board

Atty. Docket No.: 003921.00258

Group Art Unit: 2304

Examiner: Hugh M. Jones

Confirmation No. 6358

OFFICE ACTION RESPONSE ACCOMPANYING PETITION TO REVIVE

U.S. Patent and Trademark Office
Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

This paper responds to the Office Action mailed November 15, 2004, and is accompanied by a Petition For Revival of An Application For Patent Abandoned Unintentionally Under 37 C.F.R. §1.137(b).

The undersigned, and his law firm, represent the current owner of this application, Mentor Graphics Corporation. Mentor Graphics acquired this and other assets of Aptix Corporation in a transaction concluded in the summer of 2005. An Assignment of the present application, as well as other patent properties formerly owned by Aptix Corp., to Mentor Graphics, was executed on June 27, 2005 and July 6, 2005, and was recorded in the USPTO on September 1, 2005, at Reel 016945/Frame 0219. The inventor of the present application, Amr. M. Mohsen, is not affiliated with, nor employed by, present owner Mentor Graphics; he is not actively involved in this prosecution. Mentor Graphics (hereinafter "Assignee") is the real party in interest.

Following a withdrawal of this case from issue by the USPTO, the outstanding Office Action requested information concerning any litigation related to the present application. Assignee is now in a position to provide information to the Examiner responsive to his request.

Related Patents/Applications

For the convenience of the Examiner, the status of the applications and patents related to the current application, and the relationship of these applications to each other, is set forth in a tree-style patent family chart attached hereto.

Related Litigation¹

Two of the related patents are known to have been the subject of litigation. One is the patent which the Examiner identified, U.S. Patent No. 5,554,069. This patent has been involved in the following litigation: *Aptix Corp. et al. v. Quickturn Design Systems, Inc.*, Case No. C-98-00762, N.D. Cal., filed 2/26/98. This case ("the Quickturn litigation") is discussed below. The second related patent to have been involved in litigation is U.S. Patent No. 5,661,409: *Aptix Corp. v. Willmore et al.*, Case No. C-04-01522, N.D., filed 4/19/04. This case was voluntarily dismissed by Aptix within four months of being brought. See Complaint and court docket sheets, attached.

The Quickturn Litigation

The Quickturn litigation underwent extensive proceedings in the District Court for the Northern District of California (see court docket sheets, attached). Final judgment was rendered June 14, 2000 (2000 WL 852813, attached), dismissing the action as a terminating sanction for

¹ This discussion is intended to provide the Examiner with information about the litigation proceedings that have taken place, and to highlight particular filings that the Examiner may consider relevant to the prosecution of the present case. The discussion references a number of documents relating to the litigations. Copies of many of the referenced documents are being submitted, and those documents are listed in a form PTO/SB/08 which is provided so that the Examiner can make of record his consideration of those documents.

litigation misconduct found to have been committed by Aptix through the actions of its founder and CEO Amr Mohsen. That decision also held the '069 patent unenforceable based upon the same litigation misconduct.

Several appeals followed. The first appeal (No. 00-1323), by Quickturn Design Systems ("Quickturn"), sought reversal of the District Court's dismissal of Quickturn's counterclaim for abuse of process under California law. The Federal Circuit summarily affirmed the decision below on June 8, 2001 (see attached notice of affirmance under Fed.Cir.R. 36). The second appeal (Nos. 00-1468 and 00-1469) sought review of the District Court's final judgment dismissing the case as a terminating sanction, and its ruling that the '069 patent was unenforceable. The Federal Circuit affirmed the dismissal of the action as a terminating sanction for the litigation misconduct, but vacated the judgment of unenforceability. *Aptix Corp. v. Quickturn Design Systems, Inc.*, 269 F.3d 1369, 1378 (Fed. Cir. 2001) (copy attached). In its decision, the Federal Circuit noted:

In the present case, however, the record discloses no misconduct in acquisition of the patent right. Moreover, Meta and Mentor licensed the '069 patent from Aptix before the present litigation. The record does not show that either company participated in any wrongful conduct during the litigation or before the PTO. Indeed, the trial court noted: "Meta may be a victim."

In the absence of any showing of misconduct before the PTO, the '069 patent remains a presumptively valid grant of personal property.

Id. at 1377. The third appeal (No. 04-1368) was brought by Amr Mohsen personally, seeking review of the District Court's judgment voiding a security interest granted to Dr. Mohsen in the Aptix assets as a fraudulent transfer under California law. The Federal Circuit issued a written

decision affirming the judgment below. *Aptix Corp. v. Quickturn Design Systems, Inc.*, 148 Fed.Appx. 924 (Fed. Cir. 2005) (copy attached).

Much of the District Court proceedings related to the issues regarding the engineering notebooks produced by Aptix, which formed the basis of the District Court's final judgment dismissing the case, and the Federal Circuit's decision on the appeal of that judgment. The Examiner has raised the issue of the potential relevance of these proceedings to the prosecution of the present application. In particular, the Examiner states: "There appears to be questions regarding conception and reduction to practice of the claimed invention." Office Action mailed February 2, 2006, p. 3, para. 7.

Questions were raised by the litigation concerning whether Amr Mohsen could establish a date of invention for claims of the '069 patent that would precede the effective filing date of the application underlying that patent. Ultimately, however, Aptix and Meta elected not to rely on the disputed notebooks to establish an earlier date of invention. See, e.g., *Aptix Corp. v. Quickturn Design Systems, Inc.*, 2000 WL 852813 at *23 (N.D. Cal 2000) (final judgment). The earlier filing date issue raised by the notebooks is not relevant to the present application, as Assignee has not attempted to rely on those notebooks to establish a date of invention preceding the effective filing date of the present application.

Pursuant to the request for information, a review of the District Court's docket sheets (copy submitted herewith) was undertaken by the undersigned, and an attempt was made to obtain copies of entries that might possibly be relevant.

As a review of the Court's docket sheets reveals, the proceedings in the District Court included briefing on the evidentiary hearing conducted by the Court on May 9 and 10, 2000,

pertaining to the allegations of fraud on the court (Docket #s 456, 457, 459), Markman proceedings and proceedings on a number of motions brought by defendant Quickturn challenging the validity and enforceability of the '069 patent. Tentative and final claim construction rulings were handed down following a claim construction hearing (Docket #s 314 and 352). The docket sheets further indicate that the following defense related motions were brought and briefed:

- Motion by Quickturn for summary judgment of non-infringement or, in the alternative, invalidity of Mohsen U.S. Patent No. 5,544,069 (Docket # 474).
- Motion by Quickturn for summary judgment that U.S. patent 5,44,069 is invalid for failure to comply with 35 U.S.C. 112 (Docket # 475).
- Motion by plaintiffs Meta Systems, Inc. and Aptix Corp. for summary judgment on Quickturn's (1) inequitable conduct defense; (2) inequitable conduct counterclaim; and (3) derivation defense (Docket # 480).
- Motion by Quickturn for summary judgment of invalidity of Mohsen U.S. Patent 5,544,069 under 35 U.S.C. 102(f) (Docket # 482).

Assignee's undersigned representative attempted to obtain copies of the briefing on the evidentiary hearing and the docket entries pertaining to the above motions, as well as both the tentative and final rulings on claim construction. The documents for this closed case were no longer available at the Court; therefore, a document retrieval company was commissioned to request the documents from a Federal archive where they were stored. A copy of the Tentative Ruling After Claim Construction Hearing (Docket # 314) and the Final Claim Construction Ruling Order (docket # 352) was obtained, as were a copy of the Joint Claim Construction

Statement (Docket # 45) and the Supplemental Joint Claim Construction Statement (Docket # 229). Some of the motions related documents were obtained. A copy of documents that were obtained from the Federal archive, or otherwise, are being submitted herewith, and the documents submitted are listed in the attached Form PTO SB/08.

In view of the confidentiality protective order entered in the litigation, Assignee is unable to submit documents filed under seal. Quickturn's motion for summary judgment of non-infringement or, in the alternative, invalidity of Mohsen U.S. Patent No. 5,544,069 (Docket #474) was filed under seal, so a copy thereof is not being submitted. Without disclosing any confidential information, Assignee can advise that with this motion, Quickturn urged that claim 4-6 and 8 of the Mohsen '069 patent would be invalid over Butts U.S. Patent No. 5,036,473, under 35 U.S.C. §102(e), if those claims were construed to cover Quickturn's products. The District Court docket sheets show that Quickturn's Motion for summary judgment of invalidity of Mohsen U.S. Patent No. 5,544,069 under 35 U.S.C. §102(f) (Docket #482) was also filed under seal. While Assignee is unable to submit a copy of this, it is able to submit herewith a copy of plaintiffs' motion for summary judgment on this (and other) defenses (Docket #480).

Assignee has so far been unable to locate Quickturn's Post-Markman Supplemental Submission Under Local Rule 16-9(b), and the McCluskey Post-Markman Rule 26 Report referenced therein. The McCluskey Report is believed to be one of the documents (attachment No. 5) filed under seal as docket entry No. 477. No docket sheet entry was located for Quickturn's Supplemental Submission Under Local Rule 16-9(b). On information and belief, the undersigned understands this document to have been dated April 13, 2000, and to have set forth Quickturn's Post-Markman invalidity allegations as follows:

Claims 4-8 of the Mohsen '069 patent are rendered obvious under 35 U.S.C. §102(g)/§103 and §102(e)/§103 by the channel routing architecture disclosed in, *e.g.*, the 1988 Butts engineering notebook, Bates numbered QMA0016018 [dated June 3, 1988], and Fig. 6 of Butts Patent Application Serial No. 07/254,463 ('the Butts '463 application'), in combination with the article entitled "Kit offers instant insights", *Electronics*, January 23, 1975, p. 70, attached as Exhibit 4 to the *McCluskey Rule 26 Report*, and the report entitled "Digital Systems Laboratory Courses And Laboratory Developments", Cosine Committee, Commission on Education, National Academy of Engineering, March 1971, attached as Exhibit 5 to the *McCluskey Rule 26 Report* (Exhibits 4 and 5 are hereinafter collectively referred to as the "socket breadboard references"). This combination is suggested by Horowitz and Hill, *The Art of Electronics*, Chapter 12 [copyright 1980 and 1989], attached as Exhibit 12 to the *McCluskey Post-Markman Rule 26 Report*.

Claims 4-8 of the Mohsen '069 patent are also rendered obvious under 35 U.S.C. §102(b)/§103 by the Spandofer Report entitled "Synthesis of Logic Functions on an Array of Integrated Circuits", AFCRL Report No. 66-298 (October 31, 1965), attached as Exhibit 2 to the *McCluskey Rule 26 Report*, in combination with the socket breadboard references, as suggested by Horowitz and Hill, *The Art of Electronics*, Chapter 12 [copyright 1980 and 1989]

Quickturn's Post-Markman Supplemental Submission Under Local Rule 16-9(b), at 5-6 (material in brackets supplied). To the extent Assignee was able to locate the references cited by Quickturn in the above excerpt, copies of these are being submitted with an IDS being filed herewith.

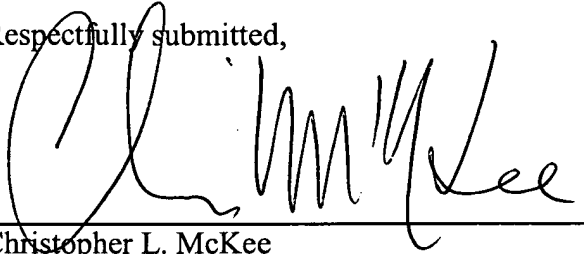
Conclusion

Assignee has endeavored to provide the Examiner with information that meets and exceeds the request for information set forth in the November 15, 2004 Office Action, in order to facilitate the further examination of the present application, and in fulfillment of the duty of disclosure. Should the Examiner have any questions or desire any further information, the Examiner is invited to telephone the undersigned at the number indicated below.

Dated: 3/71/06

Respectfully submitted,

By:


Christopher L. McKee
Registration No. 32,384

BANNER & WITCOFF, LTD.
1001 G Street, N.W., 11th Floor
Washington, D.C. 20001-4597
Tel: (202) 824-3000
Fax: (202) 824-3001

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